

REMARKS

Claim 17 has been amended by relocating the subparagraph that begins on line 10 into the subparagraph that begins on line 9. Such amendments to claims are only for the purpose of expediting the prosecution of this application and is not to be construed to be an abandonment of any of the novel concepts disclosed therein.

The office action states, "2. Claim 17 is objected to because of the following informalities: in claim 17, line 9, there appears to be an incomplete phrase. Appropriate correction is required." P.2.

Claim 17 has been amended by relocating the subparagraph beginning at line 10 into the subparagraph beginning at line 9.

The office action states, "3. Claims 17-24 are objected to because of the following informalities: term 'vibratile' is not a word. 'Vibrating' is a word that could be used. Appropriate correction is required." P.2.

This objection is respectfully traversed. Only claims 20 and 24 include vibratile, and vibratile is a word that application owner's attorneys have been using for many years to describe a vibratile surface. We enclose a copy of a page listing the dictionary definition of vibratile as "characterized by vibration" and "capable of or adapted to vibratory motion." Accordingly, withdrawal of this objection is respectfully requested.

The office action states:

4. Claims 17-19 and 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Henricksen et al (U.S. Patent No. 4,811,403).

Regarding claims 17-18, Henricksen teaches an electroacoustical device for operating in . an ambient environment comprising: an acoustic enclosure (figs. 4-5) comprising a port (92) having an exit for radiating pressure waves; an electroacoustical transducer (98) positioned in said acoustic enclosure, said electroacoustical transducer for vibrating to produce said pressure waves; a second enclosure having a first opening (110) and a second opening (112); wherein said port exit (92) is positioned near said first opening (110) so that said pressure waves are radiated into said second enclosure through said first opening (col. 9 lines 18-24), and wherein said port exit, said first opening, and said enclosure are constructed and arranged to cause air (col. 9 lines 18-24) from said ambient environment to flow into said second enclosure through said first opening; a mounting position (opposite side of 94 relative to 98 thereby lying within air flow path, col. 9 lines 10-38) for a heat producing device (amplifier, col. 9 lines 35-38) in said second enclosure positioned so that air flowing into said second enclosure through first opening from said ambient environment flows across said mounting position.

Regarding claim 19, Henricksen teaches an electroacoustical device in accordance with claim 18 wherein said heat producing element is an audio amplifier (amplifier, col. 9 lines 35-38).

Regarding claims 21-22, Henricksen teaches an electroacoustical device for operating in an ambient environment comprising: an acoustic enclosure comprising a port (110) having an exit for radiating pressure waves; an electroacoustical transducer (98) positioned in said acoustic enclosure, said electroacoustical transducer for vibrating to provide said pressure waves; an elongated second enclosure (near 94, 118) having a first extremity and a second extremity in a direction of elongation; a first opening (94, 112) at said first extremity and a second opening (106, 118) at said second extremity; wherein said port exit (110) is positioned in said first opening so that said pressure waves are radiated into said second enclosure through said first opening toward said second opening; and a mounting position (opposite side of 94 relative to 98 thereby lying within air flow path, col. 9 lines 10-38) for a heat producing device (amplifier, col. 9 lines 35-38) in said elongated second enclosure positioned so that air flowing into said opening from said ambient environment flows across said mounting position.

Regarding claim 23, Henricksen teaches an electroacoustical device in accordance with claim 22 wherein said heat producing element is an audio amplifier (amplifier, col. 9 lines 35-38). Pp.2-4.

This ground of rejection is respectfully traversed.

"It is well settled that anticipation under 35 U.S.C. 102 requires the presence in a single reference of all of the elements of a claimed invention." *Ex parte Chopra*, 229 U.S.P.Q. 230, 231 (BPA&I 1985) and cases cited.

"Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

"This court has repeatedly stated that the defense of lack of novelty (i.e., 'anticipation') can only be established by a single prior art reference which discloses each and every element of the claimed invention." *Structural Rubber Prod. Co. v. Park Rubber Co.*, 223 U.S.P.Q. 1264, 1270 (Fed. Cir. 1984), citing five prior Federal Circuit decisions since 1983 including *Connell*.

In a later analogous case the Court of Appeals for the Federal Circuit again applied this rule in reversing a denial of a motion for judgment n.o.v. after a jury finding that claims were anticipated. *Jamesbury Corp. v. Litton Industrial Prod., Inc.*, 225 U.S.P.Q. 253 (Fed. Cir. 1985).

After quoting from *Connell*, "Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim," 225 U.S.P.Q. at 256, the court observed that the patentee accomplished a constant tight contact in a ball valve by a lip on the seal or ring which interferes with the placement of the ball. The lip protruded into the area where the ball will be placed and was thus deflected after the ball was assembled into the valve. Because of this constant pressure, the patented valve was described as providing a particularly good seal when regulating a low pressure stream. The court quoted with approval from a 1967 Court of Claims decision adopting the opinion of then Commissioner and later Judge Donald E. Lane:

[T]he term "engaging the ball" recited in claims 7 and 8 means that the lip contacts the ball with sufficient force to provide a fluid tight seal. *** The Saunders flange or lip only sealingly engages the ball 1 on the upstream side when the fluid pressure forces the lip against the ball and never sealingly engages the ball on the downstream side because there is no fluid pressure there to force the lip against the ball. The Saunders sealing ring provides a compression type of

seal which depends upon the ball pressing into the material of the ring. *** The seal of Saunders depends primarily on the contact between the ball and the body of the sealing ring, and the flange or lip sealingly contacts the ball on the upstream side when the fluid pressure increases. 225 U.S.P.Q. at 258.

Relying on Jamesbury, the ITC said, "Anticipation requires looking at a reference, and comparing the disclosure of the reference with the claims of the patent in suit. A claimed device is anticipated if a single prior art reference discloses all the elements of the claimed invention as arranged in the claim." *In re Certain Floppy Disk Drives and Components Thereof*, 227 U.S.P.Q. 982, 985 (U.S. ITC 1985).

There is no disclosure in the reference of the port exit positioned near the first opening so that the pressure waves produced by the electroacoustical transducer are radiated into the second enclosure through the first opening wherein the port exit, the first opening and the enclosure are constructed and arranged to cause air from the ambient environment to flow into the second enclosure through the first opening. The reference discloses fan 106 producing the air flow, not by the construction and arrangement of the port exit, the first opening and the enclosure. Claims 18 and 19 are dependent upon and include all of the limitations of claim 17 and are also not anticipated by the reference, at least for the reasons set forth above.

Regarding claim 21, the Examiner identifies element 110 as corresponding to the recited port and elements 94, 112 as corresponding to the recited "first opening." But element 94 is a backbone or load-bearing member, and cannot be the first opening. If element 112 corresponds to the recited first opening, then the port 110 is not in the first opening. Claims 22 and 23 are dependent upon and include all the limitations of claim 21 and cannot be anticipated by the reference at least for the reasons set forth above in discussing claim 21.

Accordingly, withdrawal of the rejection of claims 17-19 and 21-23 as anticipated by the reference is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the reference regarded as corresponding to each limitation in the rejected claims.

The office action states:

5. Claims 20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henricksen.

Regarding claims 20 and 24, Henricksen teaches an electro-acoustical device, comprising: a first enclosure comprising a port (92) having a terminal point; an electroacoustical transducer (98) comprising a vibrating surface for generating pressure waves resulting in said outward airflow and said inward airflow; a second enclosure comprising a first opening (110) and a second opening (112), wherein the port terminal point is positioned near said first opening and oriented so that said port terminal outward flow flows toward said second opening and wherein said port and said electroacoustical transducer coact to cause a substantially unidirectional airflow to flow into said first opening.

Although Henricksen teaches the electroacoustical device could use any passive/active heating dissipating means (col. 6 lines 40-50), Henricksen fails to specifically teach the heat dissipating means utilizing the terminal point for outward and inward airflow to flow into/out of the first enclosure. However, the Examiner takes Official notice that it is known to use various heating dissipating means, such as fins, passive radiators, thermal conductive material, in acoustic enclosure device to create unidirectional airflow without using additional heat producing elements.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use any known heating dissipating means in the invention of Henricksen for the reason stated above. Pp. 4-5.

Claims 20 and 24 call for the electroacoustical transducer comprising a vibratile surface for generating pressure waves resulting in the outward airflow and inward airflow with the port terminal point positioned near the first opening and oriented so that the port terminal outward flow flows toward the second opening and wherein the port and the electroacoustical transducer coact to cause a substantially unidirectional airflow into the first opening. Nothing in the reference makes obvious the subject matter as a whole of the subject matter of claims 20 and 24 where the unidirectional airflow in the reference is caused by fan 106, not by the coaction of the electroacoustical transducer and the port as recited in the claims.

What the Examiner is doing is using the claims being rejected as a template or blueprint in attempting to read the rejected claims on the prior art reference.

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.¹⁵ This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."¹⁶ *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1784 (Fed. Cir. 1992).

¹⁵ *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). See also *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

¹⁶ *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600.

As the Supreme Court said in *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q. 2d 1385, 1397 (U.S. 2007)

A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. See *Graham*, 383 U.S., at 36 (warning against a "temptation to read into the prior art the teachings of the invention in issue" and instructing courts to "guard against slipping into the use of hindsight" (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F. 2d 406, 412 [141 USPQ 549] (CA6 1964))).

Accordingly, withdrawal of the rejection of claims 20 and 24 as unpatentable over the reference is respectfully requested.

The courtesy of the Examiner in conducting a diligent search is acknowledged with appreciation. The references cited, but not applied, are incapable of anticipating, suggesting or making obvious the subject matter as a whole of the invention disclosed and claimed in this application.

In view of the foregoing amendments, authorities, remarks and the inability of the prior art, alone or in combination, to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the active claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. If the Examiner believes the application is not in a condition for allowance, the Examiner is respectfully

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requested to telephone the undersigned attorney at 617-521-7014 to discuss what additional steps the Examiner believes are necessary to place the application in a condition for allowance.

Respectfully submitted,
FISH & RICHARDSON, P.C.

11 February 2008
Date: _____

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Enclosure: Definition of vibratile

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Dictionary

vibratile(vī-brā-tīl, -tīl) 

adj.

1. Characterized by **vibration**.
2. Capable of or adapted to vibratory motion.

[French, from Latin *vibrātus*, past participle of *vibrāre*, to vibrate. See *vibrate*.]

vibratilit̩y vī-brā-tīl-ty (-tīl-tē) n.

vibratile

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vibratile

Swaying or moving to and fro; vibratory.

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